REMARKS

This application is a continuation of U.S. Application Serial No. 09/792,318 (the '318 Application). In the '318 Application, claims 1-4, 6-17 and 19 were rejected in a non-final office action dated May 22, 2003; these claims were cancelled and the allowable subject matter of claims 5 and 18 were amended to provoke allowance. The present application argues patentability of non-allowed claims 1-4, 6-17 and 19 (claims 1 and 19 being independent). Since this is a continuing application, these claims are conseculatively renumbered, from 1-17, with claims 1 and 17 being independent. Claims 1 and 17 correspond, respectively, to claims 1 and 19 in the '318 Application.

Claim Rejections under 35 USC § 102(b)

Accordingly, claims 1-17 stand rejected under 35 USC § 102(b) as being anticipated by U.S. Patent No. 5,146,071 ("Ookubo"). Applicants respectfully disagree. To anticipate a claim, the reference must teach every element of the claim and "the identical invention must be shown in as complete detail as contained in the ... claim." *MPEP 2131* citing *Verdegaal Bros. V. Union Oil Co. of California,* 814 F.2d 628, 2 USPQ2d 1051 (Fed. Cir. 1987) and *Richardson v. Suzuki Motor Co.,* 868 F.2d 1226, 9 USPQ2d 1913 (Fed. Cir. 1989).

Ookubo does not teach every element of claim 1, which requires the following step elements:

(A) receiving input to change the position of a selected one of the focus lens and the zoom lens group; and

(B) separately controlling the positions of the focus lens and the zoom lens group along the optical axis such that the focus lens and the zoom lens approach no closer to one another than a selected minimum safe distance, for any selected magnification provided by the zoom lens group and the focus lens.

Ookubo shows and describes only a single focus system 70 in connection with FIG. 1. Ookubo, col. 5, lines 13-15. System 70 is therefore expressly not a zoom lens

system, as required by Applicants' claim 1. Ookubo shows a zoom lens architecture in FIG. 2 and FIG. 3. Ookubo, col., 3, lines 66-68 and col. 4, lines 1-2. In FIGs. 1A-1C, Ookubo only teaches an electronic circuit for detecting position and for driving ultrasonic motors. The Examiner points to FIG. 1A in the present action; however the text and figure associated with FIG. 1A does not teach, or suggest, a "minimum safe distance", as required by Applicants' claim 1. See Ookubo, col. 8, lines 16-68 and col. 9, lines 1-15. In FIG. 6, Ookubo shows a "minimum focus distance" – however this has nothing to do with "minimum safe distance" as in Applicants' claim 1. Ookubo does disclose movement of zoom lenses in connection with col. 10, lines 19-68, wherein "target position data" (obtained through a "formula" identified in lines 43-44 and shown in col. 9 and col. 11, lines 18-20) governs movement. A focusing operation is described with reference to three lens groups and FIG. 8A-8B. However, in these sections of Ookubo, it is again clear that no teaching or suggestion exists as to a "minimum safe distance" as in Applicants' claim 1.

Ookubo continues with flowcharts of FIG. 11; however, once again, the disclosure of Ookubo is silent as to minimum safe distance, as required in claim 1.

The Examiner further points to FIG. 14 as anticipating Applicants' claim 1. Again we disagree. In this section of Ookubo, a "third embodiment" of positioning lenses is disclosed; however the chart of FIG. 14 (and associated text) merely show positioning of zoom lenses – but nothing about a "minimum safe distance" as required in claim 1. Ookubo merely discloses (in this section) driving lenses to a "minimum focusing distance". Ookubo, col. 13, lines 29-30. Where is the suggestion within Ookubo of a "minimum safe distance"? It is non-existent.

Moving on, the Examiner further points to FIG. 15. However, once again, FIG. 15 (and the associated text) fail to teach a "minimum safe distance" of claim 1. With respect to FIG. 15, Ookubo merely shows and describes encoders and linear ultrasonic motors which cooperate to vibrate and detect movement of lenses.

Continuing, Ookubo FIG. 16 also does not teach limitations of claim 1. A ROM 56 merely stores data on driving distances Pli, P3i, in col. 15, lines 19-22 of Ookubo, to locate initial and final positions. Again, there is no teaching or suggestion of "minimum safe distance". It is noteworthy that Ookubo explains, in col. 15, lines 57-66, that driving distances Pli, P3i are determined such that the operator does not

feel an "unpleasant feeling". Where again is the suggestion of a "minimum safe distance"? Ookubo simply does not teach the limitations of claim 1.

Continuing, Ookubo teaches manual (powered) focusing in FIG. 19A, FIG. 19B. However, once again, Ookubo merely determines a target position and not any "minimum safe distance" as required within Applicants' claim 1.

Continuing, Ookubo has no disclosure of a "minimum safe distance" with respect to FIG. 21A, 21B. A "predetermined" distance is found at step F148 and F151. Sections describing FIG. 16A and FIG. 16B within Ookubo further describe suppression of vibration; but lack any teaching or suggestion of "minimum safe distance". See Ookubo, col. 17, lines 1-55.

Referring now to FIG. 23-24 (also cited by the Examiner as anticipatory to Applicants' claim 1), Ookubo teaches intermediate distance data, position detection, positional relationships, and target distances; however, again, nowhere does Ookubo teach or suggest a "minimum safe distance" as in Applicants' claim 1. Ookubo does disclose movement of lenses to ensure optical character according to an intermediate distance (see col. 19, lines 15-38), but this too bears no resemblence to the limitations of Applicants' claim 1.

Similar types of information are also taught by Ookubo in connection with remaining figures 25-32; however Ookubo is silent as to limitations of Applicants' claim 1.

Claims 2-16 depend from claim 1 and benefit from like arguments. Moreover, these claims have additional features that further patentably distinguish over Ookubo. Since Ookubo does not teach or suggest – at all – the limitations of claim 1, Ookubo clearly does not also teach or suggest elements of claims 2-16. Reconsideration of claims 1-16 is requested. We therefore expressly disagree with the Examiner's interpretation of Ookubo as set forth on pages 2-4 of the present office action.

With respect to independent claim 17, for all the foregoing reasons, Ookubo equally fails to teach or suggest "permissible working range" as required, by limitation, within claim 17. Specifically, by replacing "minimum safe distance" in the above arguments with "permissible working range", it is seen that Ookubo is equally inapplicable to claim 17. Reconsideration of claim 17 is thus requested.

Claims 1-17 stand stand rejected under 35 USC § 102(b) as being anticipated by JP Patent No. 11-281869 ("Fuji"). Applicants respectfully disagree since, among other reasons, Fuji does not teach the limitations of claims 1 and 17, failing 35 U.S.C. §102. Pursuant to MPEP §706.02, it is believed that only the English language abstract is relied upon by the Examiner for the rejection of Fuji; if this is not true, Applicants hereby request an English language translation since the other parts of Fuji are not comprehensible to Applicants. With regard to the abstract, Fuji merely discloses collision avoidance between lenses in a camera, wherein a characteristic curve is used to position a lens 3 as linked to a start operation of a zoom lens. Nowhere in the English language abstract (or the Fuji figures, from what can be ascertained) discloses a "minimum safe distance" or "permissible working range" (or like concepts) as in independent claims 1, 17. The Examiner generally recites, on pages 5-6 of the present action, Applicants' claims 1-17; however we are at a loss for any correlation between such recitation and Fuji. We see – and argue – that there is no teaching or suggestion of all claim limitations, as required in independent claims 1 and 17. This is a key failing of 35 U.S.C. §102.

The Examiner refers to paragraphs 53-82 of Fuji – however we must request an English language translation (MPEP 706.02) if the Examiner persists with this section as anticipating Applicants' claims, since these paragraphs are in Japanese. The referenced drawings (drawing 3, 4, 5) are also unreadable; therefore we further request their translation in order to respond to this objection. From what Applicants can ascertain, it does not appear that "minimum safe distance" (claims 1-16) or "permissible working range" (claim 17) are taught or suggested.

Reconsideration of claims 1-17 is requested.

Claims 1-17 stand rejected as being unpatentable over U.S. Patent No. 5,028,773 ("Hata") in view of Ookubo. Respectfully we disagree, since Hata and Ookubo does not render claims 1-17 *prima facie* obvious. The following is a quotation of from the MPEP setting forth the three basic criteria that must be met to establish a *prima facie* case of obviousness:

> To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in

the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP, §2142, citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The Examiner states that Hata discloses all of claims 1-17 except for limitations of "minimum safe distance" and "permissible working range". The Examiner then relies on Ookubo to fill the void. However, we have argued quite extensively above that Ookubo also fails to teach these limitations. Moreover, Hata is quite insufficient to anticipate claims 1-17 per Applicants' prior response and arguments against Hata (in related U.S. Application Serial No. 09/792,318). We therefore contend that the present rejection fails since the combination of Hata with Ookubo also fails to teach the claim limitations of claims 1-17; specifically both fail, among other reasons, to teach or suggest "minimum safe distance" and "permissible working range" as required by respective claims in the pending application.

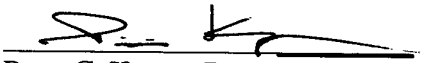
We strictly disagree with the Examiner's assessment that one of ordinary skill can combine Hata with Ookubo to render Applicants' claims 1-17. This cannot be done without hindsight. Moreover, for the reasons set forth above, it would not be reasonable to successfully modify Hata and/or Ookubo to render any of the claims since the disclosures fail to teach key limitations.

Claims 1-17 also stand rejected as being unpatentable over Hata in view of Fuji. Respectfully we disagree, since, again, these references do not render claims 1-17 *prima facie* obvious. Hata fails again for the reasons set forth above. Fuji was also argued above; it too does not teach or suggest "minimum safe distance" and "permissible working range" as required by respective claims in the pending application. The combination of Hata with Fuji is thus equally inapplicable to teaching the limitations of Applicants' claims; it is also unreasonable to successfully modify the combination to render the claims since, among other reasons, the art itself does not teach key limitations.

Based on the foregoing, it is submitted that the Applicants' inventions as defined by claims 1-17 are patentable over the art of record. Issuance of a Notice of Allowance is solicited. Applicants' attorney welcomes the opportunity to discuss the case with the Examiner in the event that there are any questions or comments regarding the response or the application.

This is intended to be a complete response to all remaining rejections of the Examiner's Office action mailed on May 22, 2003 in connection with U.S.S.N. 09/792,318.

Respectfully submitted,

By: 

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